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REMARKS

I. Amendments

Claim 1 has been amended to recite that the claimed apparatus comprises an automated or non-manual means for feeding one or more samples through at least one predetermined analyzing position. Claim 18 has been similarly amended to recite that the claimed method comprises feeding a sample sequentially by an automated or non-manual means through the sample presentation apparatus. Support for the amendments is provided by the specification as a whole, for example, at page 3, lines 11-17; page 4, lines 28-30; and page 7, lines 3-7.

No new matter has been added by any of the amendments herein.

II. Examiner interview.

Applicants thank the Examiner for the courtesy of the telephonic interview conducted on December 4, 2003. This communication is submitted pursuant to that interview.

As a result of Applicants' claim amendments and arguments in the Amendment filed July 18, 2003, the Examiner withdrew the rejections and objections of record in the Office Action mailed February 18, 2003. However, the Examiner rejected the claims under new grounds, and made the rejection final.

III. Rejection under 35 U.S.C. § 103(a)- Hammond in view of Trygstad

Claims 1, 3, 6, 7, 10, 11, 17, and 26 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over EP 896,215 to Hammond et al. ("Hammond") in view of EP 767,369 to Trygstad ("Trygstad").

The Examiner alleges that Hammond discloses a spectrometric apparatus having means for feeding a sample through at least one predetermined analyzing position, and means for temporarily fixing the sample in the analyzing position. The Examiner acknowledges that Hammond does not disclose a fixing mean having first and second holding parts which define apertures within the parts wherein the apertures themselves define an effective optical aperture in the closed position. Therefore, the Examiner relies upon Trygstad for an alleged disclosure of the features which are not disclosed or suggested by the primary reference to Hammond. The

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Examiner concludes that it would have been obvious to combine Hammond and Trygstad to obtain the claimed invention.

Applicants respectfully disagree and submit that the cited combination of Hammond and Trygstad does not suggest the claimed invention as defined by the amended claims.

Hammond

Hammond discloses a method and apparatus for spectrophotometrically analyzing a tablet. In accordance with Hammond, the tablet is "located" in a recess and a clamping force is applied to the tablet by manually displacing rods 8 and 12 and levers 11 and 15 (col. 9, lines 3-6 and 13-15).

There is no suggestion that the tablet is "located" in the recess by any kind of automated means. Conversely, there is a strong suggestion that the tablet is "located" in the recess by manual means. Specifically, at column 12, lines 16-35, Hammond discloses that the clearance 90 will be as small as conveniently possible to permit location of the tablet in the complementary shaped recess and removal of the tablet from the recess. Thus, manual feeding of a tablet would presumably be required to ensure the reliable and accurate placement of the tablet in a complementary shaped recess having the smallest possible clearance. Furthermore, manually locating the tablet in the recess and manually fastening the tablet in the recess appear to be complementary manual steps.

For all of the foregoing reasons, Applicants submit that Hammond does not disclose or suggest an automated feeding means as recited by the amended claims.

Trygstad

Trygstad discloses manually placing a sample in the sample analyzing position. Trygstad indicates that a sample is inserted into a sample well of a sample locator and covered with a masking element. The sample "locator is then manually inserted [into position] ... and aligned between the probe and the detector" (col. 3, line 56- col. 4, line 4; and col. 5, lines 46-54). Therefore, Trygstad discloses manual placement of a sample into the sample analyzing position. There is no suggestion that any non-manual means are used to place the sample in position.

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In contrast to both Hammond and Trygstad, the claimed apparatus of amended claim 1 comprises *automated* means for feeding one or more samples through at least one analyzing position. Advantageously, therefore, the present invention provides for an automated and continuous analysis of samples in which there is no need for manual handling of the samples (page 3, lines 16-17; and page 4, lines 28-30). As contemplated by the claimed invention, the term "automated" is intended to cover any method or apparatus in which the sample is fed through the analyzing position by any automated or non-manual means. The automated means in the present invention permits obtaining an optical measurement on the pharmaceutical sample with high accuracy, precision, and reliability.

The Examiner alleges that Hammond discloses a means for positioning a sample by vibrations (col. 4, line 56-col 5, line 19). Applicants submit that the disclosure relied upon by the Examiner is directed to the general position of the sample in the recess *after* it has been manually placed therein. There is no suggestion that automated means can be used to feed the sample to the recess or analyzing position.

Accordingly, both Hammond and Trygstad fail to suggest the invention of amended claim 1. Claims 2-3, 6-17, 25, and 26, which are either directly or indirectly dependent upon claim 1, are likewise not suggested by either Hammond or Trygstad, whether alone or in combination. Withdrawal of the rejection of the claims under §103(a) in view of Hammond and Trygstad is requested.

IV. Rejection under 35 U.S.C. § 103(a)- Hammond in view of Trygstad and Schilling

Claims 2, 8, 9, 12-16, and 25 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Hammond in view of Trygstad and in further view of DE 4441686 to Schilling ("Schilling").

Hammond and Trygstad have been discussed in Section III, above. Applicants submit that the remarks submitted in response to the rejection under §103(a) in view of Hammond and Trygstad are applicable and, therefore, responsive, to the rejection in further view of Schilling. In brief, Hammond and Trygstad do not suggest a sample presentation apparatus comprising

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automated means for feeding a sample through a predetermined analyzing position. Schilling does not overcome the deficiencies of Hammond and Trygstad to suggest the claimed invention. Furthermore, there is no motivation to combine Schilling, Hammond and Trygstad without destroying the intended structure, function and purpose of the respective prior art apparatuses and methods.

Schilling fails to suggest automated means for feeding a sample through at least one analyzing position.

Schilling discloses a sorting arrangement which has a spectrometer for checking goods. However, Schilling does not provide any disclosure or suggestion of automated means for feeding a sample. From the available English-language Abstract, there is no disclosure or suggestion of the nature of the means used to feed a sample to the sorting arrangement. In this regard, it is not apparent from the figures that element 1 is automated or must be manually operated. It is entirely possible that the feeding mechanism (1) must be manually operated to insert a sample into the carousel (10) and to move the carousel (10) into the analyzing position. Therefore, in the absence of impermissible hindsight, Applicants submit that Schilling fails to suggest automated means for feeding a sample through the analyzing position.

There is no motivation to combine Schilling with either Hammond or Trygstad.

Applicants further submit that there is no motivation to combine Hammond, Trygstad and Schilling without destroying the intended structure, function and purpose of the respective prior art apparatuses and methods.

As discussed in Section III, above, Hammond does not disclose or suggest an automated feeding means as recited by the amended claims. Rather, there is a strong suggestion that Hammond manually locates a tablet in the recess and manually secures the tablet in the recess to prevent vibrations. Likewise, Trygstad manually feeds and secures a tablet in the sample compartment with a masking element and springs which abut and engage the sample to prevent movement during analysis.

For the reasons set forth in this Section IV, Applicants submit that Schilling does not suggest automated means for feeding a sample to an analyzing position. Thus, Schilling does not

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overcome the deficiencies of Hammond and Trygstad to suggest the claimed invention. For the sake of argument, however, even if Schilling is taken as disclosing automated means for feeding a sample, there is no motivation to combine such a hypothetical disclosure with the respective apparatuses of Hammond and/or Trygstad which manually feed and secure a sample in the sample compartment.

Specifically, there would be no logical purpose to automatically dispense a sample into a sample compartment, and then subsequently manipulate the sample manually to secure it in the sample compartment. Such a "hybrid" process would not result in any substantial reduction in time, cost and labor necessary to feed and secure the sample. Instead, the person of ordinary skill in the art would have merely placed and secured the sample in the sample compartment in one manual operation, thereby simplifying the apparatus and the process for obtaining a spectrometric analysis.

Consequently, in the absence of impermissible hindsight, there is no reason to combine Hammond, Trygstad and Schilling. Rather, in view of the incompatibility of their respective disclosures, Applicants submit that the combination of references is tantamount to a hindsight reconstruction of the claimed invention. Accordingly, withdrawal of the rejection of claims 2, 8, 9, 12-16, and 25 under §103(a) is requested.

V. Rejection under 35 U.S.C. § 103(a)- Hammond in view of Schilling and Trygstad

Claims 18-23 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Hammond in view of Schilling and Trygstad.

Applicants submit that their comments in Section IV, above, are applicable and, therefore, responsive to the rejection of claims 18-23. Accordingly, the rejection of claims 18-23 under §103(a) is improper and should be withdrawn.

Applicants re-submitted an earlier-filed Information Disclosure Statement ("IDS") on July 18, 2003. However, an initialed copy of Form PTO-1449 was not returned to Applicants with the most recent Office Action. Accordingly, Applicants request that an initialed copy of

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Form PTO-1449 be included with the next communication from the PTO to indicate consideration of the documents cited in the IDS.

VI. Conclusion

Upon entry of this Amendment, claims 1-3, 6-23, 25, and 26 are pending. Applicants respectfully submit that claims 1-3, 6-23, 25, and 26 have been distinguished over the cited prior art, and are directed to patentable subject matter. Accordingly, Applicants request allowance of the claims.

Authorization is hereby given to charge any fee due in connection with this communication to Deposit Account No. 23-1703.

Dated: Dec. 16, 2003

Respectfully submitted,

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